

REMARKS

Claims 1-20 were originally filed in the present application.

Claims 1-20 are pending in the present application.

Claims 1-20 were rejected in the November 3, 2005 Office Action.

No claims have been allowed.

No claims are amendeded herein

Claims 1-20 remain in the present application.

Reconsideration of the claims is respectfully requested in light of the following argument.

In Section 2 of the April 28, 2006 Office Action, the Examiner rejected Claims 1, 2, 5-7, 10-12, 16, 17 and 20 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,587,684 to *Hsu, et al.* (hereafter "Hsu") and U.S. Patent No. 6,421,727 to *Reifer, et al.* (hereafter "Reifer") in view of U.S. Patent No. 6,243,572 to *Chow, et al.* (hereafter "Chow"). In Section 3 of the Office Action, the Examiner rejected Claims 3, 4, 8, 9, 13-15, 18 and 19 under 35 U.S.C. § 103(a) as unpatentable over Hsu, Reifer, Chow and in further view of U.S. Patent No. 6,314,282 to *Weber, et al.* (hereafter "Weber"). The Applicants respectfully traverse the rejections.

The Applicants direct the Examiner's attention to Claim 1, which contains the unique and novel limitations emphasized below:

1. For use in a wireless network comprising a plurality of base stations, each of said base stations capable of communicating with a plurality of mobile stations, a service provisioning system capable of provisioning a first one of said plurality of mobile stations comprising:

a database capable of storing a service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format; and

a provisioning controller coupled to said database capable of receiving a notification indicating that said first mobile station is unprovisioned and further capable, in response to receipt of said notification, of retrieving said service provisioning file from said database and transmitting said service provisioning file to said first mobile station, wherein receipt of said service provisioning file causes said first mobile station to automatically execute said mobile station service provisioning program in said service provisioning file, execution of said mobile station service provisioning program automatically provisioning said first mobile station without further interaction from a service operator. (*Emphasis added*).

The Applicants respectfully assert that the above-emphasized limitations are not disclosed in Hsu, Reifer, Chow, Weber, or any combination of them.

Reversing his previous position, the Examiner now concedes that Hsu does not teach this limitation. The Examiner makes no allegation that this limitation is taught by Chow or Weber, and indeed, they do not teach or suggest this limitation. The Examiner now relies on Reifer for this teaching.

Reifer is a satellite-based communications system that uses a browser system for service provisioning. The Examiner relies on col. 9, lines 7-15:

FIG. 9 is a diagram which illustrates the SPNet system of the present invention. In accordance with the present teachings, a browser at the Service Provider's location is used to download a JAVA application which, when executed, provides for service provisioning including service activation, suspension, reactivation and deactivation for telephone, paging, roaming and other services from a database at the GBS.

It is clear that neither this passage, nor any other passage in Reifer, teaches or suggests a database capable of storing a service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format, where the database must meet the other

limitations of claim 1. For example, claim 1 requires that the provisioning controller is coupled to the database – there is no provisioning controller coupled to Reifer's "GBS".

Further, it is clear that even if Hsu's database 28 (alleged by the Examiner to correspond to the claimed database in the November 3, 2005 Office Action) were modified according to Reifer to include a "JAVA application which, when executed, provides for service provisioning including service activation, suspension, reactivation and deactivation for telephone, paging, roaming and other services", it would not be operable in Hsu's system. Nothing in Hsu, Chow, or Weber teach or suggest that the mobile station is even capable of executing a JAVA application, and so Reifer's application cannot, in fact, be executed in the proposed system of Hsu, Chow, and Weber.

Claim 1 also requires that receipt of the service provisioning file causes said first mobile station to automatically execute the mobile station service provisioning program. Nothing in the art of record teaches this feature.

The Examiner relies on Chow for this teaching, at col. 2, lines 32-45:

The subscriber buys their phone at a retail outlet and the retail outlet records the purchase in a service provider database. The point-of sale information may include subscriber name, address, credit card number, unique mobile station identification number (MIN), optional personal identification number (PIN) and other verification number. The user activates their service by activating their phone over-the-air when they first communicate from their selected home neighborhood zone. The system automatically verifies the user by comparing the point-of-sale information with the information input by the subscriber from their home neighborhood zone. Over-the-air activation occurs without the assistance of service personnel.

Nothing in this passage teaches or suggests that receipt of a service provisioning file causes a first mobile station to automatically execute a mobile station service provisioning program. Here, the only thing done "automatically" is by the system, not the mobile station. This passage expressly requires that information be input by the subscriber, presumably into the mobile station. No art of record teaches or suggests the limitation of "wherein receipt of said service provisioning file causes said first mobile station to automatically execute said mobile station service provisioning program in said service provisioning file, execution of said mobile station service provisioning program automatically provisioning said first mobile station without further interaction from a service operator" as required by claim 1.

Finally, there is no proper motivation to combine Reifer with the other references. The motivation to combine or modify must be specific to the actual teachings sought to be combined. "In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention." (*Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) emphasis added). "When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention." (*In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998), emphasis

added).

There is not specific motivation in the art, or even alleged by the Examiner, to incorporate Reifer's JAVA application into the proposed combination system of Hsu, Weber, and Chow. None of these other references could even execute it, and there is no teaching in the art that such a modification would provide any advantage at all. The Examiner's alleged motivation, "in order to enable the device to easier adapt to more recent technology" is completely unsupported in the art, and is not specifically related at all to the proposed modification, as required. Further, this general statement of motivation isn't even correct – if "more recent technology" does not provide any known advantage in a given system, and there is no evidence in this case that it would do so, then modifying a system to incorporate the "more recent technology" is an unnecessary and wasted expense.

For these reasons, the Applicants respectfully assert that neither Hsu, Chow, Reifer, nor Weber, nor any combination of the cited references teaches, a service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format that is automatically executed when received by a mobile station. This being the case, Claim 1 presents patentable subject matter over all art of record. Additionally, dependent Claims 2-5, which depend from Claim 1, contain all of the unique and novel limitations recited in independent Claim 1. Claims 2-5 are therefore patentable over all art of record.

Furthermore, independent Claims 6, 11 and 16 recite limitations that are analogous to the unique and novel limitations recited in Claim 1. This being the case, Claims 6, 11 and 16 are patentable over all art of record. Dependent Claims 7-10, 12-15 and 17-20, which depend from

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Claims 6, 11 and 16, respectively, contain all of the unique and novel limitations recited in independent Claims 6, 11 and 16. Thus, Claims 7-10, 12-15 and 17-20 are patentable over all art of record.

SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.

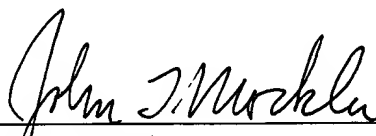
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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